

REMARKS

In response to the Examiner's objection to the drawings, the phrase "the foam pad disposed within the envelope" has been deleted from the claim, thereby eliminating the need for drawing corrections.

In response to the Examiner's rejections of claims 1 – 8, claim 1 has been amended, and claims 2 – 8 have been cancelled. The cancellation of claim 7 moots the requirement for antecedent basis in claim 7.

In response to the Examiner's objection to the use of the undefined term "capulet," this term has been deleted from the claim, and the specification has been amended to replace said term with the term – epaulet -- .

Antecedent basis for amending claim 1 to include the limitation of uniformity of increase of thickness of the foam pad is provided by **FIGURE 1B**.

THE EXAMINER'S RATIONALE

In objecting to the drawings, the Examiner observes that the drawings must show every feature specified in the claims. Therefore, the subject matter of claim 2 must be shown or the feature(s) cancelled from the claim. Specifically, the foam pad disposed **within** the envelope must be shown; the drawing show a foam pad **4**, disposed on top of the envelope **8**.

Claim 3 is objected to because of the use of the undefined term "capulet."

Claim 7 is objected to because the phrase "the foam pad" lacks proper antecedent basis in the claim.

In rejecting claims 1 – 3 and 5 under 35 U.S.C. 102(b) over U.S. Patent Number 4,654,893 to Meyers et al., the Examiner states that Meyers et al. disclose a shoulder pad accessory arm pad comprising an elongated padded member (80) defining first and second opposite ends, the padded member being constructed and arranged for disposal on an arm of a wearer, to protect the arm from injury, means for attaching (83) the first end of the padded member to a shoulder pad (26) of the wearer, and means for attaching (88) the second end of the padded member to the arm of the wearer, to secure the padded member to the arm of the wearer. The padded member comprises a foam pad (86) disposed within and attached to a peripheral elastic envelope (glaze being a thin, water-impermeable and somewhat "elastic" surface). As seen in Figure 2, for example, the padded member has first and second open ends, the first end having first attachment means (83) for attaching the arm pad to a portion of the shoulder pad, and the second end having second attachment means (88) for attaching the arm pad to the arm of the wearer. The second attachment means (88) comprise a strap with hook-and-loop fasteners along its entirety.

In rejecting claims 1 – 3 and 5 under 35 U.S.C. 102(b) over U.S. Patent Number 4,467,475 to Gregory et al. the Examiner states that Gregory et al. disclose a shoulder pad accessory arm pad comprising an elongated padded member (3000) defining first and second opposite ends, the padded member being constructed and arranged for disposal on an arm of a wearer, to protect the arm from injury; means for attaching (3100) the first end of the padded member to a shoulder pad (2000) of the wearer; and means for

attaching (3020) the second end of the padded member to the arm of the wearer, to secure the padded member to the arm of the wearer. As seen in Figures 5 and 11, for example, the padded member has first and second open ends, the first end having first attachment means (3100) for attaching the arm pad to a portion of the shoulder pad, and the second end has second attachment means (3020) for attaching the arm pad to the arm of the wearer. The first (3100) and second (3020) attachment means comprise elastic bands.

In rejecting claim 6 under 35 U.S.C. 103(a) over Meyers et al. in view of U.S. Patent Number 5,911,197 to Schmid, the Examiner states that Schmid discloses an arm pad accessory having a padded member (16) for disposal on a wearer's arm, with first and second ends. First attachment means (96) attach the padded member to a shoulder pad, while second attachment means (98) attach the padded member to the wearer's arm. Schmid discloses that the second attachment means may be elastic straps with hook-and-loop fasteners for improved mobility and comfort. The Examiner concludes that it would have been obvious to one skilled in the art at the time the invention was made to have provided the shoulder pad arm accessory disclosed by Meyers et al., wherein the padded member is attached to the wearer's arm by an elastic strap with hook-and-loop fasteners, as taught by Schmid, to provide improved mobility and comfort.

In rejecting claims 7 and 8 under 35 U.S.C. 103(a) over Meyers et al. in view of Gregory et al., the Examiner states that Meyers et al. disclose the previously described shoulder pad accessory arm pad, comprising a padded member for disposal on an arm of a wearer, means for attaching the first end of the padded member to a shoulder pad of the wearer, and means for attaching the second end of the padded member to the arm of the wearer. Meyers et al. specify padded member have a foam pad disposed within the padded member. Meyers et al. do not specify that the foam pad have a thickness that increases continuously from the first end to the second end.

Gregory et al. disclose a shoulder pad accessory arm pad, having several members. Gregory et al. disclose that the padded member can have a variable thickness, increasing from the first end to the second end, to provide added rigidity and strength to the padded member.

The Examiner concludes that it would have been obvious to one skilled in the art at the time the invention was made to have provided the shoulder pad accessory arm pad

disclosed by Meyers et al., wherein the thickness of the padded member increases from the first end to the second end, as taught by Gregory et al., to improve rigidity and strength.

APPLICANT'S ARGUMENTS FOR PATENTABILITY

As amended, claim 1 recites a foam pad for disposal on an arm of a wearer, the pad having a thickness which increases continuously and uniformly from one end of the foam pad to the other end of the foam pad. It is submitted that none of the prior art, whether taken as single documents or as a combination of documents, anticipates, discloses, or makes obvious the limitations recited above.

In rejecting original claims 7 and 8 (currently cancelled), the Examiner states that Gregory et al. disclose a shoulder pad accessory arm pad having several padded members; and that Gregory et al. disclose the padded member can have a variable thickness, increasing from the first end to the second end, to provide added rigidity and strength to the padded member.

It is submitted that the shoulder flap 2000 shown in FIGS. 3 – 5 and 11 – 12 is clearly depicted as disposed **on the shoulder, not on the arm**, of the wearer. The flap 2000 is the only element that has a variable thickness. The arm pad 3000 certainly does not.

In fact, the shoulder flaps 2000 are not padded at all. Under “DETAILED DESCRIPTION OF THE DRAWINGS,” the patent reads “Referring to the drawings, in FIGS. 1 – 16 there is shown an upper body protector 100 comprising an upper body shield, **a pair of shoulder flaps 2000**, and a pair of shoulder caps or epaulets 3000.” (Second paragraph.) Later in the specification, the patent reads “As seen in FIG. 5, the shoulder flap has variable thickness and contour edge 2018, to provide added rigidity and strength.”

The objective and function of the continuous and uniform variation in thickness of the foam pad claimed by applicant are to permit and enable an unlimited range of motion of the user's arm at the shoulder. (Specification, paragraph 0012, lines 7 – 11.) The shoulder flaps 2000 provide no such freedom of movement of the user's arm, nor are they constructed and arranged to do so.

Meyers et al. disclose a pair of upper-arm shoulder pads 80a, 80b having a variable thickness. It is apparent, however, from inspection of FIG. 5, that the variation in thickness of the upper-arm pad 80a (and pad 80b, which is identical) is not continuous

and is certainly not uniform. Specifically, the thickness of the pad 80a changes discontinuously and non-uniformly at two different points between one of its end and its other end. It will be apparent to those skilled in the art that a continuous and uniform variation in thickness, as claimed by applicant and illustrated in **FIG. 1B**, is far more effective than a discontinuous and non-uniform variation for effecting unrestricted freedom of movement of the user's arm.

It is applicant's opinion that the foregoing points of difference discussed above are sufficient grounds for allowance of claim 1. However, there are other differences between the prior art and the claimed invention. These other differences are relevant because a prior-art reference must be taken as a whole, for what it fairly teaches. In re Wesslau, 147 USPQ 791.

Applicant submits that the following considerations are pertinent to the allowance of claim 1 as amended.

In regard to the Schmid patent, it relates to a dog training device that has an upper arm pad which does not vary in thickness. The device has no portability, and is not suitable for upper-arm protection while playing football, which is a prime objective of applicant's invention.

In regard to the patent to Gregory et al., the device described therein is essentially a shield for the upper body, the shield embracing the chest, back, and shoulder. It is made of injection-molded plastic with padding underneath. While this may be desirable for motocross or other motor sports, it would not be in keeping with the goal of flexible full-range motion in all planes of movement. The arm pad is made of stiff flexible plastic. There is no tapering of the arm pad 2000, as in the claimed invention; only the shoulder flaps 3000 are tapered, and these are not padded. Moreover, the shoulder flaps 3000 are stitched and riveted to the arm pads 2000, so as not to be readily removable. A user would have to purchase the entire body protector in order to have the upper-arm pads 2000. The latter are intended for motor sports, and are not suitable for football. The patent itself cites the differences in weight of the shoulder pad versus conventional football shoulder pads. Additionally, disposition of the upper-arm pads relative to the humerus is not conducive to protection of the lateral portion of the humerus, where most blows fall on a ball-carrier in a football game. In fact, the anterior position of the pad

would interfere with a ball carrier's ability to grip the ball with his forearm and humerus. The rearward edge 3030 of the shoulder flap 3000 is disposed at the edge of the medial axis, and the forward edge 3040 is decisively anterior to the central axis of the humerus bone covering the upper and frontal portion of the arm.

With regard to the patent to Meyer et al., the tapered upper-arm pad is, as in the patent to Gregory et al., fastened to the rest of the protective device, and can not be purchased or used alone as a single item. This is the overall basic distinction between the claimed invention and the inventions cited by the Examiner; viz., applicant's arm pad is an **accessory** arm pad (preamble to claim 1) constructed and arranged to be portable and to be connected **on the spot** to the shoulder pads and to the arms of the user. The prior art cited by the Examiner discloses devices which are integral, and which include arm pads solely **as integral parts** of the devices. They are **not** constructed and arranged to be connected on the spot to the shoulder pads and to the arms of the user, nor are they portable so as to be easily transported to the spot where they are needed. As stated in applicant's specification, paragraph 003, lines 25 – 28: "Consequently, there is a need for a protective sports pad which permits the wearer to **quickly position and remove** the pad. . . . The present invention provides such a protective pad."

Reconsideration, withdrawal of the objections and rejections, and allowance of claim 1 as currently amended are respectfully requested.

SUMMARY, CONCLUSIONS, AND PETITION

In conclusion, it is submitted that, in view of the amendments and arguments herein presented, the application is in condition for allowance. Reconsideration, withdrawal of the objections and rejections, and allowance of the application are respectfully requested.

Respectfully submitted

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Date of Signature